

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-29 under 35 U.S.C. §101 as being directed to non-statutory subject matter, rejected claims 1-29 under 35 U.S.C. § 112, second paragraph as being indefinite; and rejected claims 1-31 under 35 U.S.C. § 103(a) as being unpatentable over Inanoria (US Patent Application Publication No. 2004/0046789) in view of Pena et al. (US Patent Application Publication No. 2003/0225829).

Applicants have amended claims 1, 16, and 28-31. Claim 1 was amended to incorporate the subject matter of claim 4. Claims 16 and 28-31 also incorporate the same subject matter. Applicants have also cancelled claims 4 and 25-27 without prejudice or disclaimer. Claims 1-3, 5-24, and 28-31 remain pending.

**I. Rejection of claims 1-29 under 35 U.S.C. §101**

The Examiner rejected claims 1-29 under 35 U.S.C. § 101 because the “[c]urrent Office policy is that an information carrier is not considered a tangible embodiment.” (Office Action, page 2). Applicants respectfully disagree.

“When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” See M.P.E.P. § 2106 (IV) p. 2100-12. A claim to a data structure stored on a computer readable medium that increases computer efficiency has

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

been held statutory. *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Furthermore, a claim to a computer having a specific data structure stored in memory has been held statutory as a product-by-process claim. *In re Warmerdam*, 33 F.3d 1354, 1360-1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

However, to expedite prosecution, Applicants have amended claims 1 and 16 to recite a “computer program product tangibly embedded in a computer-readable storage medium.” Claims 1-3 and 5-24 are thus not embodied in an information carrier. Rather, these claims positively recite a specific data structure that is tangibly embedded in a computer-readable storage medium. Therefore, claims 1-3 and 5-24 fall squarely within the categories of patentable subject matter, and Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3 and 5-24 under 35 U.S.C. §101. The rejection of claim 4 is moot, since this claim has been cancelled.

With regard to the rejection of claims 25-27, although Applicants disagree with the Examiner’s allegations that the claims do “not produce a useful result,” to expedite prosecution, Applicants have cancelled these claims.

With regard to the rejections of claims 28-29, the Examiner states that these claims are not “patent eligible because the invention recited therein does not produce a useful, concrete and tangible result.” (Office Action, page 3). Applicants respectfully disagree.

According to the Federal Circuit, whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d at 1375. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not

abstract and has practical utility. See *State Street*, 149 F.3d at 1373, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Circ. 1999), also cited in M.P.E.P. § 2106(II)(A). “[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation.” See *State Street*, 149 F.3d at 1601.

Claims 28-29 are statutory because they include recitations that produce a “concrete, tangible and useful” result and, therefore recite a practical application that is not abstract. Claim 28 relates to a method for developing user interfaces by “receiving user input specifying a view composition . . . and storing the view composition in a repository.” Claim 29 relates to an apparatus comprising a processor and means, connected to the processor, for “receiving user input specifying a view composition” and means for “storing the view composition in a repository.” The claimed steps of “receiving user input specifying a view composition” and “storing the view composition in a repository” provide a useful, concrete, and tangible result in the form of, for example, a view repository.

Further, the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” issued on October 26, 2005, indicate, “[i]n determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result is “useful, tangible and concrete.” In this application, receiving user input specifying a view composition and storing the view composition in a repository are

undeniably useful, and constitute a tangible and concrete final result in that they define how to make and store the view composition.

For at least the foregoing reasons, claims 28-29 are statutory under 35 U.S.C. § 101. Applicants thus request that the Examiner withdraw the rejection of claims 28-29 under 35 U.S.C. § 101.

**II. Rejection of claims 1-29 under 35 U.S.C. § 112**

The Examiner rejected claims 1-29 because the word “potential” in claims 1 and 28-29 “is a relative term which renders the claim indefinite.” (Office Action, page 3). Although Applicants disagree with the Examiner’s contentions, in order to expedite prosecution, Applicants have amended claims 1 and 28-29 to recite “specifying a transition.” Applicants thus request the Examiner to withdraw the rejection of claims 1, 25, and 28-29, as well as dependent claims 2-3 and 5-15. The rejection of claims 4 and 25-27 are moot, since these claim were cancelled.

**III. Rejection of claims 1-31 under 35 U.S.C. § 103(a)**

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Here, the cited references cannot support a rejection under 35 U.S.C. § 103(a) because, among other things, Inanoria and Pena et al., taken alone or in any proper combination, do not disclose, teach, or suggest each and every feature recited in

Applicants' Amended claims 1, 16, and 28-31. Amended claims 1, 16, and 28-31 recite inter alia, "wherein each navigation link comprises an association between an exit point in the first view and an entry point in the second view."

Referencing to now-cancelled claim 4, the Examiner correctly acknowledges that "Inanoria does not explicitly teach this limitation." (Office Action, page 6). The Examiner then relies on Pena et al. for the asserted disclosure of the above-recited claim recitations by citing paragraph [0095] in of Pena et al. stating that "Pena teaches using a navigation link to exit one page and enter another." Id. Applicants respectfully disagree.

Pena et al. is directed to platform and language-independent delivery of page-based content. (Abstract). The cited portions of Pena et al. describe a processor parsing "IDML markup and [returning] back the valid IDML link used for action transition from page to page or other content source (i.e., moving from one IDML page to the next, similar to a hyperlink)." (0095). Pena et al. is thus merely describing transition from one page to another. Pena et al. is completely silent on any "navigation link" much less "each navigation link comprises an association between an exit point in the first view and an entry point in the second view." Therefore, Pena et al. fails to teach or suggest this claim recitation. If the Examiner maintains this rejection for the amended claims, Applicants respectfully request the Examiner to point out what portions of Pena et al. alleged teach or suggest these claims limitations.

Accordingly, Inanoria and Pena et al., taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicants' amended independent claims 1, 16, and 28-31, and, therefore, cannot support a rejection of these

claims or dependent claims 2-3, 5-15, and 17-24 under 35 U.S.C. § 103(a). The rejections of claim 4 and 25-27 are moot, since these claims were cancelled. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate.

**IV. Conclusion**

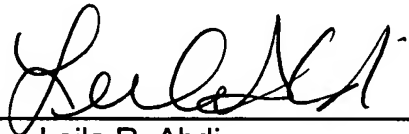
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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